Appl. No. 09/463,675
Grp./A.U. 1751

REMARKS/ARGUMENTS

Favorable consideration and allowance of the instant application is respectfully requested in view of the following remarks.

The Examiner's rejections, as they pertain to the patentability of the claims, are respectfully traversed.

The Examiner has maintained his election/restriction requirement on the grounds that the special technical feature identified by Applicant as being present in each of the groups identified by the Examiner fails to make a contribution over the prior art due to the citation of X and Y references in the PCT Search Report.

Applicant requests that the Examiner cite the relevant legal precedent in support of this position since Applicant is unaware of any rule, regulation or case law which provides that the citation of X and Y references in a PCT Search Report renders the special technical feature incapable, per se, of making a contribution over the prior art. Unless, of course, the Examiner has made this determination on his own in which case Applicant maintains its request for the citation involving the relevant legal precedent which allows the Examiner to make such a determination.

The Examiner also states at page 3, paragraph 4, of Paper No. 11 that the present application contains claims 23-30 drawn to an **invention non-elected with traverse** in Paper No. 10 and that a complete response to the final rejection must include cancellation of non-elected or other appropriate action. The meaning and/or purpose of this paragraph, and specifically the highlighted portion, is unclear to Applicant, particularly in view of the Examiner's statement in Paper No. 11, page 2, paragraph 1 that this restriction is NOT being made final.

Claims 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Weinelt et al. (US 5,880,086). This rejection is respectfully traversed for the following reasons.

Initially, Applicant would like to note that it is clear in the law that, to establish a prima facie case of obviousness under 35 U.S.C. 103 based upon a single reference, the Office must show an art-recognized motivation to modify the reference in the manner asserted by the Office. In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984). This being said, Applicant respectfully submits that the Weinelt reference fails to render the claimed invention prima facie obvious for the following reasons.

First, this reference teaches the use of **BOTH** the nonionic surfactant component and the polyol component as being merely optional. Since their presence in the composition in the Weinelt composition is thus clearly **unnecessary** based on this reference's teaching, one of ordinary skill in the art may not be motivated to employ **BOTH** components. The reasons for this lack of motivation may include, all the costs associated with the use of the materials, said costs being ultimately passed on to the consumer.

Secondly, the reference fails to teach or suggest the use of these two **unnecessary** in the claimed ratio by weight. Thus, not only would one of ordinary skill in the art need to choose to employ **both** of these unnecessary components in the composition of Weinelt, but they would also need to be motivated to employ them in the claimed ratio by weight. Clearly there is no basis in fact present in the disclosure of the Weinelt reference from whence this requisite motivation might stem. Moreover, the Examiner notes in Paper No. 11, page 4, paragraph 7. that examples 4 and 5 are described as being "low-viscosity". It is seen, however, that the claimed invention is not disclosed in these examples. Consequently, one of ordinary skill in the art, wishing to formulate such a composition having a low viscosity would **NOT** be motivated to modify the teachings of the Weinelt reference in a manner which would read on the claimed invention since a low-viscosity

formulation is already described in examples 4 and 5, without the need for modification.

Accordingly, for all of the above-disclosed reasons, reconsideration and withdrawal of this rejection is respectfully requested.

Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinelt et al. (US 5,880,086) in view of Severns et al. (US 5,531,910). This rejection is respectfully traversed for the following reasons.

The shortcomings associated with Weinelt reference are as outlined above. It is Applicant's position that one of ordinary skill in the art **would not** be motivated to employ both a nonionic surfactant and a polyol component since these two elements are taught as being optional only. Moreover, since low-viscosity formulations such as those noted by the Examiner (examples 4 and 5) can be obtained without modifying the Weinelt composition in a way which would read on the claimed invention, there exists no basis in fact within the reference from which the requisite motivation to employ the claimed combination of the two optional components, might stem.

As for the Severns reference, it is merely relied upon for its teaching regarding the use of glycerol. However, based on the above-described lack teaching necessary to motivate the routineer to wish to employ an unnecessary component such as glycerol, as taught by Weinelt, a combination of the teachings of these two references would nevertheless fail to render the claimed invention prima facie obvious.

Accordingly, for all of the above-stated reasons, reconsideration and withdrawal of this rejection is respectfully requested.

It is believed that the foregoing reply is completely responsive under 37 CFR 1.111 and that all grounds for rejection are completely avoided and/or overcome. A Notice of Allowance is therefore earnestly requested.

The Examiner is requested to telephone the undersigned attorney if any further

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questions remain which can be resolved by a telephone interview.

Respectfully submitted,

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